

OCT 31 2006

Docket No. 023004.0104N3US

Application Serial No. 10/759,841

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**REMARKS**

The Office Action dated July 31, 2006 has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. The above amendments to the claims and the following remarks are respectfully submitted. By this Amendment, Applicants have cancelled claims 70, 71, 77, 78, 81 and 83-114 and amended claims 66, 67, 72-75, 79 and 80. In addition, Applicants have added new claims 115-162. No new matter has been added. Support for the amendments to claims 66 and 67 may be found on page 18, lines 11-14; page 22 lines 16-21; and page 19, lines 14-22. Support for the new claims may be found throughout the specification, for example:

Claim 115— page 7, lines 18-19.

Claim 116— page 7, lines 22-25.

Claim 117— page 7, line 27.

Claim 118— page 7, line 27.

Claim 119— page 7, line 26.

Claim 120— page 7, line 28.

Claim 121— page 8, lines 6-7.

Claim 122— page 7, lines 18-20.

Claim 123— page 6, lines 21-22; page 12, lines 1-4.

Claim 124— page 6, line 20; page 12, lines 1-4.

Claim 125— page 12, line 2; page 16, line 30.

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- Claim 126— page 19, lines 24-26.
- Claim 127— page 19, lines 28-29.
- Claim 128— page 17, lines 19-22.
- Claim 129— page 17, lines 19-22.
- Claim 130— page 18, line 13.
- Claim 131— page 18, line 13.
- Claim 132— page 16, lines 22-23.
- Claim 133— page 16, lines 22-26.
- Claim 134— page 23, line 11; page 4, lines 3-4.
- Claim 135— page 23, line 11.
- Claim 136— page 23, line 11.
- Claim 137— page 24, lines 23-24.
- Claim 138— page 4, lines 3-4; page 24, lines 21-29.
- Claim 139— page 7, lines 18-19.
- Claim 140— page 7, lines 22-25.
- Claim 141— page 7, line 27.
- Claim 142— page 7, line 27.
- Claim 143— page 7, line 26.
- Claim 144— page 7, line 28.

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Claim 145— page 8, lines 6-7.

Claim 146— page 7, lines 18-20.

Claim 147— page 6, lines 21-22; page 12, lines 1-4.

Claim 148— page 6, line 20; page 12, lines 1-4.

Claim 149— page 12, line 2; page 16, line 30

Claim 150— page 19, lines 24-26.

Claim 151— page 19, lines 28-29.

Claim 152— page 17, lines 19-22.

Claim 153— page 17, lines 19-22.

Claim 154— page 18, line 13.

Claim 155— page 18, line 13.

Claim 156— page 16, lines 22-23.

Claim 157— page 16, lines 22-26.

Claim 158— page 24, lines 23-24.

Claim 159— page 12, line 25 – page 13, line 4.

Claim 160— page 13, lines 19-22.

Claim 161— page 22, lines 18-19.

Claim 162— page 24, lines 18-19.

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**Response to Restriction Requirement**

The application presently contains claims 66-114. In an Office Action dated July 31, 2006, the Examiner required restriction to one of the following inventions under 35 U.S.C.

§ 121:

Group I: Claims 66-74, 82-92, 102-112 and 114, drawn to an isolated genetic construct;

and

Group II: Claims 75-81, 92-101 and 113, drawn to a method of delaying or repressing the expression of a target gene in an animal cell.

The Examiner states that the groups are distinct because the product can be used in either an *in vitro* or *in vivo* prokaryotic cell as opposed to its use in a method of delaying or repressing the expression of a target gene in an animal cell.

The Examiner further states that if Group I is elected, Applicants are required to elect a species from the following: a T7 promoter, a t3 promoter, a SP6 promoter, a lac operator-promoter, a tac promoter, an SV40 late promoter, an RSV-LTR promoter and a CMV IE promoter. The Examiner contends that the promoters are distinct because each promoter has a distinct structure.

Applicants respectfully traverse the restriction requirement. Applicants contend that the Patent Office has not demonstrated that the search and examination of the entire application would impose an undue burden. Applicants respectfully assert that it would not be an undue burden to examine either the composition and method claims together. Applicants submit that the complete examination would be handled most expeditiously by treating all of the pending

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claims as a single entity. As MPEP 803 directs, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants respectfully submit that the Examiner has not shown that a search and examination of the entire application would cause a serious burden.

Furthermore, Applicants submit that the Examiner has not alleged a credible or substantive use of the products in a materially different process. The Examiner has merely suggested that "the product can be used in either an in vitro or in vivo prokaryotic cell" without providing any details of what this use might be. Merely alleging another "use" does not meet the requirements of MPEP § 806.05(h); some substance must be given to the allegation. Moreover, the Examiner has not taken into account the suitability of the claimed product for the intended use as claimed in the methods claims. Claims 66 and 67 as amended recite that the terminator sequence "contains a polyadenylation signal and is active in the (animal) cell"; clearly the products are not suitable for use in a prokaryotic cell. Insofar as the restriction requirement might have applied to the claims prior to amendment, Applicant respectfully submit that the requirement should be withdrawn in view of the amendments.

To be fully responsive, Applicants elect Group I, claims 66-74, 82-92, 102-112 and 114, drawn to an isolated genetic construct. All of newly added claims 115-162 are dependent claims and included in Group I. With respect to the requirement for an election of a species from the list of promoter sequences, Applicants have herein cancelled claims 83-114 which included the claims that recited the alleged patentably distinct species, thereby rendering the requirement moot. Nevertheless, for the sake of completion in the response, Applicants elect the species of an SV40 late promoter.

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Applicants note the Examiner's acknowledgement that upon indication of allowable subject matter, process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to a final rejection or allowance, whichever is earlier. Applicants reserve the right to file continuation or divisional applications drawn to the non-elected inventions and claims.

Should the Examiner have any questions regarding this application, the Examiner is invited to telephone the undersigned at the number provided.

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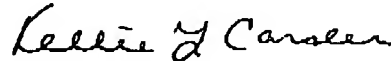
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Applicants submit concurrently a request for extension of time under 37 C.F.R. 1.136 and the accompanying fee. In the event that any additional extensions of time are necessary to prevent the abandonment of this patent application, then such extension of time are hereby petitioned. The U.S. Patent and Trademark Office is hereby authorized to charge any fees that may be required in conjunction with this submission to Deposit Account Number 50-2228, referencing matter number 023004.0104N3US.

Respectfully submitted,



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